

REMARKS

In response to the Office Action mailed November 3, 2003, Applicant respectfully requests reconsideration. To further the prosecution of this application, amendments have been made in the claims, and the claims as presented are believed to be in allowable condition.

Claims 1-23 were previously pending in this application. Claims 1-8 are amended herein. No new claims have been added, and no claims have been canceled. As a result, claims 1-23 remain pending for examination, with claims 1, 9 and 16 being independent.

Rejections Under 35 U.S.C. §103(a)**I. Claims 1-6, 8 and 23**

Claims 1-6, 8 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,705,852 to Orihara et al. ("Orihara") in view of U.S. Patent No, 5,723,907 to Houdeau ("Houdeau"). Applicant respectfully traverses this rejection.

Claim 1 has been amended to recite a self-adhesive electronic circuit including a planar base having first and second base surfaces, an antenna attached on the first surface of the base, a chip connected to the antenna, and a double faced adhesive having first and second adhesive surfaces, wherein the first adhesive surface is glued on one of the base surfaces and the second adhesive surface forms an outward adhesive surface of the self-adhesive electronic circuit.

Although Applicant does not concede the propriety of the asserted combination (as discussed below with reference to claims 9-22), amended claim 1 clearly distinguishes over any combination of Orihara and Houdeau. Specifically, neither Orihara nor Houdeau discloses or suggests a self-adhesive electronic circuit, and certainly not a self-adhesive electronic circuit including a double-faced adhesive having first and second adhesive surfaces, wherein the first adhesive surface is glued on a base surface and the second adhesive surface forms an outward adhesive surface. Because the asserted combination fails to meet the limitations of claim 1, claim 1 is not obvious in view of the asserted combination, and the rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Claims 2-8 and 23 depend from claim 1 and are allowable for at least the same reasons.

II. Claims 9-22

Claims 9-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Orihara in view of Houdeau, and further in view of U.S. Patent No. 6,089,461 to Murohara (“Murohara”). Applicant respectfully traverses this rejection, as the Office Action fails to set forth a prima facie case of obviousness, and the claims patentably distinguish over the asserted combination.

A. The Office Action Fails To Set Forth A Prima Facie Case Of Obviousness

The rejection of claims 9-22 under 35 U.S.C. §103(a) is improper because the Office Action has failed to establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, hindsight knowledge of the Applicant’s disclosure may not be relied upon, so that the Office Action must identify what structure it is believed that one of skill in the art would have been led to based upon the combined teachings of the prior art. See MPEP §2142. It is respectfully asserted that the Office Action fails to meet this initial burden, as the Office Action fails to specify what circuit configuration the Examiner believes that one skilled in the art would have been led to based upon the combined teachings of Orihara and Houdeau. In this respect, the Office Action merely picks and chooses various portions of the two references that are believed to show the claimed features. This is an improper use of hindsight. MPEP §2142.

The failure to establish a prima facie case of obviousness through the picking and choosing of features to reconstruct the claimed invention is further demonstrated by the fact that the Office Action supports the rejection of several claims by picking different features from mutually exclusive embodiments in the references. For example, in ¶3, the Office Action relies on the Fig. 1B embodiment of Orihara to purportedly meet the claim limitation of an adhesive glued on a surface of the base, and the entirely different Fig. 5 and 6 embodiments (which do not include an adhesive) to purportedly show other features. Thus, the Office Action characterizes Orihara as teaching an electronic circuit including a combination of features that Orihara, in fact, does not teach as being present in any single circuit. This is impermissible, and demonstrates that hindsight has improperly been employed, rather than following the teachings of the prior art to determine what type of electronic circuit one skilled in the art would have been led to prior to Applicant’s invention.

In addition, motivation to combine the references must be found. MPEP §2141. The Office Action states that it would have been obvious to apply the disclosure of Houdeau to Orihara to better protect the chip of Orihara from the environment. However, Orihara provides no indication that greater protection from the environment is desirable, and in any case shows (FIG. 6E) a chip 6 which is completely encased in resin 9. Thus, one of skill in the art would not have been motivated by Houdeau to modify the chip of Orihara to further protect it from the environment.

Similarly, the Office Action states that the proposed modification would provide Orihara “with a more feasible system” due to the shortening of the connecting wires of Orihara. Neither Orihara nor Houdeau provides any indication that Orihara is not a feasible system, or that shortening of connecting wires is even desirable. Moreover, one of the embodiments of Orihara relied upon in the rejection is the Fig. 1B embodiment, wherein connecting wires are not even employed. As a result, if motivated to avoid long connecting wires, one skilled in the art would have followed the teachings of Orihara and adopted one of the embodiments disclosed therein which does not use connecting wires – the skilled person would not have been motivated by the teachings of Houdeau to make any modification at all.

For each of the reasons discussed above, the Office Action fails to set forth a *prima facie* case of obviousness. Accordingly, the Applicant respectfully asserts that the rejection of claims 9-15 under 35 U.S.C. §103(a) should be withdrawn.

B. The Claims Patentably Distinguish Over The Asserted Combination

1. Claims 9-15

Claim 9 recites an electronic circuit comprising a base having first and second surfaces; an antenna supported by the first surface of the base; a double faced adhesive adhered to the first surface of the base and having a thickness in a direction extending away from the first surface, the double faced adhesive having an opening, wherein at least a portion of the antenna is disposed in the opening; and an electronic chip disposed at least partially in the opening and electrically coupled to the antenna, the electronic chip having a height in a direction extending away from the first surface; wherein the thickness of the double faced adhesive is greater than or equal to the height of the electronic chip.

The Office Action contends that the combination of Orihara and Houdeau disclose all of the limitations of claim 9, with the exception of an antenna having at least a portion disposed in an opening in the double faced adhesive, and a double faced adhesive having a thickness greater than or equal to the height of the electronic chip. The Office Action also asserts that Murohara discloses an antenna disposed at least partially in an opening in a double faced adhesive, and a double faced adhesive having a thickness greater than or equal to the height of the electronic chip. The Applicant respectfully disagrees.

In ¶5, the Office Action contends that Murohara discloses an antenna having a portion disposed in an opening in an “adhesive agent” 14, which purportedly has a thickness which is greater than the height of the electronic chip. Applicant disagrees. Element 14 of Murohara is not a double faced adhesive, but a resin. Murohara provides absolutely no disclosure or suggestion that this resin has any adhesive properties, stating only that the resin is interposed between front and back sheet materials 12, 13, and that a wireless module M is embedded within (col. 4, lines 23-25). Murohara fails to disclose any adhesive, and certainly not an adhesive having an opening in which at least a portion of an antenna is disposed, or an adhesive having a thickness greater than or equal to the height of an electronic chip. As a result, the asserted combination fails to meet the limitations of claim 9, and the rejection of claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 10-15 depend from claim 9 and are patentable for at least the same reasons.

2. Claims 16-22

Claim 16 recites an electronic circuit, comprising a base having first and second surfaces; an antenna supported by the first surface of the base; a double faced adhesive adhered to the first surface of the base, the double faced adhesive having an opening, wherein at least a portion of the antenna is disposed in the opening; and an electronic chip disposed at least partially in the opening and electrically coupled to the antenna; wherein the electronic chip is spaced from and does not contact the double faced adhesive.

As discussed above, the asserted combination fails to disclose an antenna disposed at least partially in an opening formed in a double faced adhesive. Thus, the asserted combination

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fails to meet the limitations of claim 16. Accordingly, the Applicant respectfully requests that the rejection of claim 16 under 35 U.S.C. §103(a) be withdrawn.

Claims 17-22 depend from claim 16 and are patentable for at least the same reasons.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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